

RL



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,429	09/15/1999	JOHN S. HENDRICKS	5815	7434

38598 7590 10/15/2004

ANDREWS KURTH L.L.P.
1701 PENNSYLVANIA AVENUE, N.W. SUITE 300
WASHINGTON, DC 20006

EXAMINER

KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/396,429	Applicant(s) HENDRICKS ET AL.	
	Examiner Andrew Y Koenig	Art Unit 2611	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 04 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3-16,18-32,34-43 and 45-59.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


CHRIS GRANT
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: The applicant's arguments are not persuasive, the applicant argues that the instant case is a division of 07/991,074 and is therefore the claims have benefit of the earlier filing date of the parent (09 December 1992), thereby rendering Granger of record as not being prior art in that Granger is filed after the effective filing date of the instant application.

The examiner has reviewed the cited portions of the parent application (07/991,074) and has found insufficient support for the independent claims for the hardware upgrade comprising a modem. With respect to the support for the independent claims, the applicant has merely alleged that the independent claims are fully disclosed in the parent application. However, the applicant has not provided any evidence in the parent application (07/991,074) to support this position.

Further, the examiner notes that in reviewing the parent application, the hardware upgrade (700) is connected to the set top terminal (720), such as shown in figure 7b, wherein the modem (627) is located in the set top terminal, not in the hardware upgrade as claimed.

Accordingly, the benefit of priority for the parent application (07/991,074) of 09 December 1992 will not apply to the claims of the instant application.

The applicant argues that the parent application (07/991,074) is sufficient in satisfying the written description requirement for claims, 10-13, 15, 20-22, 51-54, and 56. As discussed with respect to the support of the independent claims, the parent application does not support the same type of hardware upgrade as claimed in the instant application, therefore the support provided is not persuasive that the applicant had the invention at the time of 09 December 1992.